

REMARKS

In the Office Action^[1], the Examiner took the following actions:

rejected claim 27 under 35 U.S.C. §112;

rejected claims 1-4, 6-10, 12-16, 18-23, 25, and 27 under 35 U.S.C. §102(b) as being unpatentable over *Johnson et al.* (5,615,408, "*Johnson*");

rejected claims 28 and 29 under 35 U.S.C. §102(e) as being unpatentable over *Pillay et al.* (2002/0042763 A1, "*Pillay*");

rejected claims 5 and 11 under 35 U.S.C. §103(a) as being obvious over *Johnson* in view of *Natsuno* (7,231,202, "*Natsuno*");

rejected claims 17, 24, and 26 under 35 U.S.C. §103(a) as being obvious over *Johnson*; and

rejected claims 1-29 under statutory double patenting;

Applicant has amended claims 27. Claims 1-29 remain pending.

I. Regarding the rejection of claim 27 under 35 U.S.C. § 112 second paragraph

Regarding the rejection of claim 27 under U.S.C. § 112, second paragraph, the Examiner asserts that "the phrase 'may provide' renders the claim indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention." (Office Action at page 3). In response, Applicant has amended claims 27 to remove "may." Therefore, Applicant requests that the Examiner withdraw the rejection of claim 27 under U.S.C. § 112, second paragraph.

^[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. Regarding the rejection of claims 1-4, 6-10, 12-16, 18-23, 25, and 27 under 35 U.S.C. § 102(e) as being unpatentable over *Johnson*

Applicant respectfully traverses the rejection of claims 1-4, 6-10, 12-16, 18-23, 25, and 27 under 35 U.S.C. § 102(e) as anticipated by *Johnson*. In order to properly establish that *Johnson* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 defines a credit management system, including "a credit rules engine, said credit rules engine applying credit rules to generate internal scoring and internal credit limits from information input into said credit management system." *Johnson* fails to teach or suggest at least this element of claim 1.

In addressing this element, the Examiner relies on column 8, line 57 - column 9, line 17 of *Johnson*, which discloses:

After a credit score is obtained, it is stored in a credit scores database which is maintained by the fraud detection system. . . . [i]f known by the telecommunications service provider or carrier, an initial credit score for the customer is entered in the credit scores database. If the initial credit score is not known, an initial credit score may be obtained from the credit bureau and stored in the credit scores database . . . the credit risk manager 131 periodically obtains updated credit scores from a credit bureau for each subscriber and determines whether the credit risk associated with each subscriber has changed. If the risk has changed, the credit risk manager may adjust the credit limit being provided to the subscriber accordingly. (emphasis added)

Johnson thus discloses using a credit score obtained from a credit bureau to determine the credit limit for each subscriber. *Johnson* only collects credit scores from an external credit bureau and periodically updates those external scores. Therefore, *Johnson* does not teach “a credit rules engine, said credit rules engine applying credit rules to generate internal scoring and internal credit limits from information input into said credit management system (emphasis added).

Accordingly, for at least these reasons, *Johnson* does not anticipate independent claim 1. Claims 2-4 depend from claim 1 and are thus also allowable for at least the same reasons as that discussed above for claim 1.

Independent claims 6, 12, and 16, while of different scope from claim 1 and each other, recite elements similar to those of claim 1 and are thus also allowable over *Johnson* for reasons similar to those discussed above for claim 1. Dependent claims 7-10, 13-15, and 18 are also allowable at least due to their dependence from claims 6, 12, and 16, respectively.

III. Regarding the rejection of claims 28 and 29 under 35 U.S.C. § 102(e) as being unpatentable over *Pillay*

Applicants respectfully traverse the rejection of claims 28 and 29 under 35 U.S.C. § 102(e) as anticipated by *Pillay*. *Pillay* fails to teach each and every element of claims 28 and 29.

Independent claim 1 defines a credit authorization system, including “means for determining if the credit request can be accepted in view of the global credit limit and

the global payment obligation of the customer requesting the credit.” *Pillay* fails to teach or suggest at least this element of claim 1.

In addressing this element, the Examiner relies on paragraph 72 of *Pillay*, which discloses:

the seller company makes a wish-to-sell inquiry to the EC [electronic commerce] site about merchandise that the user wishes to sell . . . the purchaser company makes a wish-to-buy inquiry about desired merchandise presented to the EC site . . . the purchaser company makes a wish-to-buy application . . . the seller company makes a wish-to-sell application . . . it is determined in the debts and credits management authority 90 whether the transaction is within the transaction limit or not, and if the transaction is within the transaction limit, then the transaction is established ([0072] (emphasis added)).

Pillay thus discloses a method for business-to-business electronic commerce in which buying and selling limits of purchasers and sellers, respectively, are compared in determining whether a transaction is within a defined transaction limit. However, neither this portion of *Pillay*, nor any other portion, teaches “means for determining if the credit request can be accepted in view of the global credit limit and the global payment obligation of the customer requesting the credit,” as recited in claim 1 (emphasis added).

Accordingly, for at least these reasons, *Pillay* does not anticipate independent claim 1. Claims 2-4 depend from claim 1 and are thus also allowable for at least the same reasons as that discussed above for claim 1.

Independent claims 9, 16, and 21, while of different scope from claim 1 and each other, recite elements similar to those of claim 1 and are thus also allowable over *Pillay* for reasons similar to those discussed above for claim 1. Dependent claims 10-15,

17-20, and 22-24 are also allowable at least due to their dependence from claims 9, 16, and 21, respectively.

IV. Regarding the rejections of claims 5 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Johnson* in view of *Natsuno*

Applicant respectfully traverses the Examiner's rejection of claims 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Natsuno*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements."

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the

prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claims 5 depends from claim 1 and, thus, incorporates each and every element recited therein. As noted above, *Johnson* fails to teach or suggest “a credit rules engine, said credit rules engine applying credit rules to generate internal scoring and internal credit limits from information input into said credit management system” as recited in claim 1 (emphasis added). The Examiner cited *Natsuno* as a teaching of information input comprising customer profession and age information (See Office Action at 13). Even assuming the Examiner’s characterization of *Natsuno* is correct, *Natsuno* fails to cure the deficiencies of *Johnson*. That is, *Natsuno* also fails to teach or suggest “a credit rules engine, said credit rules engine applying credit rules to generate internal scoring and internal credit limits from information input into said credit management system” as recited in claim 1 (emphasis added). The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 5.

In view of the mischaracterization of the references, as discussed above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claimed combination. Thus no *prima facie* case of obviousness has been established.

Further, the Examiner states "one of ordinary skill in the arts would have found motivation to combine these teaching for the purpose of managing credit information of system subscribers". Even if the combination of references could achieve the claimed combination, which it cannot, this is not a proper statement of motivation to combine the prior art. For at least these reasons, *Johnson* and *Natsuno* therefore fail to support a *prima facie* case of obviousness. The rejection of claim 5 under 35 U.S.C. §103 as being obvious from *Johnson* in view of *Natsuno* is thus improper and should be withdrawn.

Similarly, Claim 11 depends from claim 6 and thus incorporates each and every element recited therein. For the same reasons stated above, no *prima facie* case of obviousness is established with respect to claims 11 based on the combination of *Johnson* and *Natsuno*. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 11 under § 103(a).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5 and 11.

**V. Regarding the rejections of claims 17, 24, and 26 under
35 U.S.C. §103(a) as being unpatentable over *Johnson***

In addition, Appellants note that *Johnson* is the only reference relied upon by the Examiner for this particular rejection. The M.P.E.P. sets forth that

[t]he distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. M.P.E.P. § 706.02(IV).

The M.P.E.P. clearly instructs that, for a proper 35 U.S.C. § 103 rejection, “the reference teachings must somehow be modified in order to meet the claims.” Id. Therefore, if the Examiner applies a 35 U.S.C. § 103(a) rejection based on *Johnson*, he must articulate how and why *Johnson* could be modified to supposedly teach each and every claim element. The Examiner does not explain how or why *Johnson* could be modified, other than to make a generalized allegation that “it would have been obvious to the skilled artisan because the inclusion of such types would have been an obvious matter of design choice in light of the invention already disclose[d] by *Johnson*” 9/26/07 Office Action, p 14, 15.

Moreover, “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” M.P.E.P. § 706.02(j). The Examiner’s rejections are not properly communicated, as there is no proper explanation of why one of ordinary skill in the art at

the time the invention was made would have been motivated to make the proposed modification to meet the elements of Appellants' independent claims.

The M.P.E.P. further instructs that,

[a]fter indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) *an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.* Id., italics added.

In this rejection, the Examiner has not set forth "an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification." Id. Accordingly, no *prima facie* case of obviousness has been established and the rejection of claims 17, 24, and 26 under 35 U.S.C. §103 should be withdrawn.

VI. Double Patenting

Claims 1-29 were provisionally rejected on the ground of statutory-type double patenting as allegedly being unpatentable over claims 1-21 and 26-33 of copending Application 10/631,211 (Office Action at 16). Applicant respectfully traverses the double patenting rejection and requests that the provisional rejection be held in abeyance until one of the two copending applications is allowed.

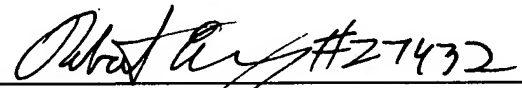
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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